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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,310	05/07/2007	Terry O'Halloran	PA1645.ap.US	9252

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EXAMINER	
CHAN, ALLEN	
ART UNIT	PAPER NUMBER
3718	

NOTIFICATION DATE	DELIVERY MODE
12/01/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOMail@traskbritt.com

Office Action Summary	Application No.	Applicant(s)	
	10/591,310	O'HALLORAN ET AL.	
	Examiner	Art Unit	
	ALLEN CHAN	3718	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 August 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1-14* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1-14* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In view of the Appeal Brief filed on August 8th, 2011, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

After careful consideration of comments and arguments provided in appellant's appeal brief dated August 8th, 2011, the examiner is withdrawing the finality of the final rejection dated February 9th, 2011. Claims 1-14 are currently pending in the application.

Double Patenting

1. Claims 1-14 of this application conflict with claims 1-13 and 15-20 of Application No. 12/012,230. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 and 15-20 of copending Application No. 12/012,230. Although the conflicting claims are not identical, they are not patentably distinct from each other because the above claims are directed to a game having simulated/virtual reels and scatter symbols, where the scatter symbols are variable state scatter symbols and wherein the probability of the scatter symbols being in an active state or an inactive state is dependent on the size of the player's wager relative to the maximum allowable wager.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 2003/0236116 A1) in view of Rodgers et al. (US 2003/0064802 A1) and further in view of Giobbi et al. (US 6,155,925).

Regarding claims 1 and 9, Marks et al. discloses a method of providing a jackpot in a gaming machine used to play a game, said machine having multiple simulated reels

used in the game, and at least one pay line, including at least the steps of determining a player's wager (see par. [0006]), playing the game, so that the simulated reels assume a specific configuration showing symbols across said reels used in the game, wherein one or more of said symbols can be a scatter symbol (see figs. 1A-1C and par. [0068]), and determining if scatter symbols appear across said reels used in the game in a predefined manner, and if so then paying said jackpot (see par. [0069]).

However, Marks et al. does not explicitly disclose that the scatter symbols can be a *variable state* scatter symbol, the variable state being either an active state, whereby said variable state scatter symbol acts as a scatter symbol, or an inactive state, whereby said variable state scatter symbol is not considered to be a scatter symbol, and wherein the probability of a variable state scatter symbol having an active state is dependent upon the size of the player's wager.

Rodgers et al. teaches a game where after the symbols are displayed, the symbols may be transformed into special symbols based on a transformation probability determined by the processor (see fig. 3, par. [0041], [0042], once a symbol is transformed, a special symbol is then activated). This is substantially similar to activating symbols because a symbol that is not transformed does not provide the player with any special award akin to how an inactive scatter symbol does not provide the player with a special award or jackpot and a symbol that is transformed provides the player with a special award akin to how an active symbol provides the player with a special award or jackpot. In addition, activating a scatter symbol could be interpreted to be *transforming* an inactive scatter symbol to an active scatter symbol. It would have

been obvious to one of ordinary skill in the art at the time the invention was made to combine the gaming machine and scatter symbols of Marks et al. with the symbol transformation of Rodgers et al. in order to transform (or activate) symbols into functional or special symbols for the evaluation of an award (see Rodgers, par. [0010]).

However, the combination of Marks et al. and Rodgers et al. still lacks wherein the probability of a variable state scatter symbol having an active state is dependent upon the size of the player's wager.

Giobbi et al. teaches a game where symbols can be activated for a game depending on the size of the player's wager (see fig. 6a-6e, and col. 6, lines 45-61, larger wagers activate symbols for large fish, very large fish, etc.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the gaming machine of Marks et al. and Rodgers et al. with the wager dependent symbols of Giobbi et al. such that variations of the wager amount will affect the payout percentage of the game (see Giobbi, col. 2, lines 34-47). Larger wager amounts would give the player an increased chance of winning in general in addition to the chance at higher value awards, such as a jackpot.

Regarding claims 2 and 10, Marks et al. discloses that the jackpot can be won based upon the scatter symbols (see par. [0068]). Rodgers et al. teaches the probability of symbols being transformed or activated as discussed above. Giobbi et al. teaches a linear relationship between the size of the wagers and the symbols that will be activated (see fig. 6a-6e). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the gaming machine of Marks et al. and Rodgers et

al. with the wager dependent symbols of Giobbi et al. such that variations of the wager amount will affect the payout percentage of the game (see Giobbi, col. 2, lines 34-47).

Regarding claims 3 and 11, Marks et al. discloses scatter and wild symbols for a game (see par. [0068]-[0070]). It is obvious that these symbols can be used in any manner in a game, at the discretion of the casino operator.

Regarding claims 4 and 12, Giobbi et al. teaches that symbols can be activated depending on the size of the player's wager relative to a maximum possible wager (see fig. 6a-6e, col. 6, lines 45-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the gaming machine of Marks et al. and Rodgers et al. with the wager dependent symbols of Giobbi et al. such that variations of the wager amount will affect the payout percentage of the game (see Giobbi, col. 2, lines 34-47).

Regarding claims 5 and 6, Marks et al. discloses that the jackpot can be accumulated across a plurality of linked machines or on a single machine (see par. [0011]).

Regarding claims 7 and 14, the limitations of the claim have been discussed above with regards to claims 1 and 4 (for claim 7) and claims 9 and 12 (for claim 14).

Regarding claims 8 and 13, Marks et al. also discloses providing a progressive jackpot which is incremented from wagers on a plurality of machines (see par. [0011]). Thus, it is inherent that there is a central jackpot controller (i.e. a server) for managing the game and the jackpot.

Response to Arguments

7. Applicant's arguments with respect to Marks et al. have been fully considered but they are not persuasive.

Regarding applicant's argument that Marks et al. does not disclose a variable state scatter symbol, the examiner notes that Marks et al. discloses that one or more of the symbols can be a scatter symbol as discussed above. Although Marks et al. does not explicitly disclose variable state scatter symbols, Rodgers et al. teaches special symbols that can be activated. Thus, the combination of Marks et al., Rodgers et al. and Giobbi et al. would produce the claimed invention.

8. Applicant's arguments with respect to Ward in the rejection(s) of claim(s) 1-14 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Marks et al., Rodgers et al. and Giobbi et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALLEN CHAN whose telephone number is (571)270-5529. The examiner can normally be reached on Monday through Thursday 11:00 AM to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALLEN CHAN/
Examiner, Art Unit 3718
11/11/2011

/Peter DungBa Vo/

Supervisory Patent Examiner, Art Unit 3718